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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,721	03/27/2001	Ronald P. Sansone	F-236	1333
919	7590	08/25/2005	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,721

Applicant(s)

SANSONE ET AL.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/26/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-6 are pending.
2. Applicant's arguments filed 7/26/05, with respect to Manduley-Hilt references have been fully considered and are persuasive. The Final of Office Action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kanevsky-Apostolopoulos-Howell.

Claim Objections

3. Claim 1 contains the negative limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 101

4. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For an invention to be labeled as having statutory subject matter it must be within the statutory class that is described thoroughly in #101 (ex. machine, process, manufacture or composition of matter).

Currently, claims 1-6 are geared towards "A method that enables a recipient to

inform a carrier about the mail delivery” which is not within one of the classes of the invention that is set forth in the §101 law.

The “A method wherein the recipient notifies the carrier” comprising the steps of (a) opening the mail, (b) return the mail to the sender, (c) delivering mail, (d) notification options, display merely an conceptual idea and do not produce a useful, definite, and concrete results.

The “A method that enables a recipient to inform a carrier about the mail delivery” and “A method wherein the recipient notifies the carrier” which encompasses the steps of (a)-(d) as dictated are merely an conceptual idea and doesn't involve any technological art (computer or software) therefore identified as being non-statutory.

Claim Rejections - 35 USC § 112

5. Claims 1-6 are rejected under 35 U.S.C., second paragraph, as being indefinite for failing to particularly point out and distinctly claim the' subject matter which applicants regards as the invention.

Claim 1 is not clearly defined considering the interpretation of the preamble which states “A method that enables a recipient to inform a carrier about the mail deliver” , but there are no procedures or limitations mentioned that state the measure in which the “recipients informs the carrier” in the body of the claim.

Claim Rejections - 35 USC § 112

6. Claims 1-6 are rejected under 35 U.S.C. 1 12, first paragraph, pertaining to the disclosure which is not enabling. Some type of computer system or computer software is vital for this invention, but its not included in the claims, therefore not making it enable by the disclosure. A computer system is essential for this invention to be of novelty or usefulness.

Double Patenting

Claims 1-6 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-31 of copending Application No. 09/818,800. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

(‘800) 1. A method that enables a recipient to inform a carrier of the manner in which the recipient would like the mail delivered, said method comprises the steps of:

depositing with the carrier mail containing the recipient's name and physical address and the sender's name and address;

placing a unique number on the mail; capturing the name, physical address of the recipient and the sender, and the unique number;

translating the name and physical address of the recipient into an e-mail address;

notifying the recipient of the availability of the deposited mail by the unique number assigned to the mail;

notifying the carrier of the manner in which the recipient would like the mail delivered; and

delivering mail to the recipient in the manner specified by the recipient to the carrier.

(claim 28) the carrier is notified via e-mail of the manner in which the recipient would like the mail delivered.

(Application) 1. A method that enables a recipient to inform a carrier of the manner in which the recipient would like the mail delivered, said method comprises the steps of:

depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address;

translating the name and physical address of the recipient into an e-mail address
capturing the name and physical address of the recipient, and the sender from the
physical mail;

notifying the recipient of the availability of the deposited physical mail;

notifying the carrier of the manner in which the recipient would like the physical mail
delivered;

notifying the carrier that the sender does not elect the deposited physical mail to be
diverted; and

if the sender elects to permit the recipient to divert the physical mail, delivering physical
mail to the recipient in the manner specified by the recipient to the carrier.

It was clearly that the sender permits the options to recipient to select the
delivery process is equivalent to the carrier permits the recipient divert the mail.

Furthermore, there is no apparent reason why applicant would be prevented from
presenting claims corresponding to those of the instant application in the other
copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA
1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable by Kanevsky [5,648,916] in view of Apostolopoulos et al [Apostolopoulos 6,868,083 B2] and further in view of Howell [5,794,221].

8. As per claim 1, Kanevsky discloses a method that enables a recipient to inform a carrier of the manner in which the recipient would like the mail delivered, said method comprises the steps of:

depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address [Kanevsky, paper mail 12, the carrier (post office) 14, sender 10, Fig 1];

translating the name and physical address of the recipient into an e-mail address [Kanevsky, the mail was chosen is transformed to email, col 2 lines 20-63, Fig 1]

capturing the name and physical address of the recipient, and the sender from the physical mail [Kanevsky, the address of destination point, col 3 lines 15-20];

notifying the recipient of the availability of the deposited physical mail [Kanevsky, notification of receipt, col 3 lines 45-50; col 6 lines 55-65];

notifying the carrier of the manner in which the recipient would like the physical mail delivered [Kanevsky, inform the post office, col 3 lines 52-60];

However Kanevsky does not explicitly detail

"notifying the carrier that the sender does *not* elect the deposited physical mail to be diverted"; and

In the same endeavor, Apostolopoulos discloses a method and system for communication employing path diversity wherein an email application with a path

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diversity service informs the source or sender the appropriate path to user [col 11 lines 39-65, Fig 11]. It was clear that if the system allows the notifying or informing the sender or carrier select or not select the mail to be diverted or not as a design choice of recipient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of diversity path and notify the sender as taught by Apostolopoulos into the Kanevsky's apparatus in order to utilize the control of email delivery. Doing so would provide a more effective, efficient and comprehensive way to communicate with people either by email addresses or physical mailing addresses.

However Kanevsky- Apostolopoulos does not detail

"if the sender elects to permit the recipient to divert the physical mail, delivering physical mail to the recipient in the manner specified by the recipient to the carrier".

It was well-known in the art that the sender/owner can permit/grant the recipient the access right to a particular object or document as taught by Howell [Howell, abstract, col 1 lines 47-60; col 2 lines 34-54].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of permit the recipient access right to a selected document as taught by Howell into the Kanevsky-Apostolopoulos apparatus in order to utilize the control of email delivery. Doing so would provide a more effective, efficient and comprehensive way to communicate with people either by email addresses or physical mailing addresses.

9. As per claims 2, Kanevsky-Apostolopoulos-Howell disclose the sender places an indication on the mail specifying that the mail should not be diverted by the recipient (see rejection claim 1).

10. As per claim 3, Kanevsky-Apostolopoulos-Howell disclose charging the sender for placing an indication on the mail specifying that the mail should not be diverted by the recipient (see rejection claim 1).

11. As per claim 4, Kanevsky-Apostolopoulos-Howell disclose the sender places an indication on the mail specifying that the mail should be delivered only as specified by the sender (see rejection claim 1).

12. As per claim 5, Kanevsky-Apostolopoulos-Howell disclose charging the sender for placing an indication on the mail specifying that the mail should be delivered only as specified by the sender (see rejection claim 1).

13. As per claim 6, Kanevsky-Apostolopoulos-Howell disclose the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered (see rejection claim 1).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-

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272-3904. The examiner can normally be reached on Monday-Thursday from 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Thong Vu', with a stylized flourish at the end.